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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,611	03/30/2001	Gregory L. Miller	42390.P10732	6045

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John P. Ward
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026

EXAMINER

CASIANO, ANGEL L

ART UNIT

PAPER NUMBER

2182

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,611

Applicant(s)

MILLER, GREGORY L.

Examiner

Angel L. Casiano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12,14-20,22-26,28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-12,14-20,22-26,28 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. The present Office Action is in response to Amendment submitted 17 November 2003.
2. Claims 1, 3-12, 14-20, 22-26, 28 and 30 are pending.

Specification

3. Objection to the Specification has been overcome with the corrections included in the present Amendment.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 20 and 22-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 20 recites "*a power switch to cause the setup software to be loaded and executed by the processor if the power switch is pressed at a time when the apparatus is turned off and is held for at least a predetermined period of time, and to cause the setup software to be prevented from being loaded and executed by the processor*". Therefore, the cited limitation is unclear, since it does not cite a condition that prevents the software from being loaded and executed.

Claims 22-25 depend directly upon claim 20 and are therefore rejected under the same basis.

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-12, 14-20, 22-26, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broyles et al. [US 6,356,965 B1].

Regarding claim 1, Broyles et al. teaches an apparatus (see Abstract) including a processor (see Abstract), a port to connect an input device (see col. 3, line 50; col. 11, lines 62-64), and firmware memory containing software to support the input device (see col. 11, lines 64-65). In the reference, if the apparatus is off (see col. 5, lines 56-60) and a power switch is pressed (see col. 6, lines 2-3), then software supporting the input device is loaded (see col. 5, lines 26-27; col. 6, lines 3-6; col. 12, lines 60-64). The reference however, does not explicitly teach *pressing* and *holding* the cited switch for a *predetermined period of time* as a condition to load and execute the software. Nonetheless, the reference explicitly teaches a “pressable key” or “pressure sensor” as a triggering device for the purpose of controlling software (see col. 3, lines 15-23). Accordingly, one of ordinary skill in the art would have been motivated to combine the cited “power switch” and “pressure sensor” in order to discriminate among different actions to be taken regarding loading the software, since Broyles et al. explicitly teaches this functionality.

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As for claim 3, Broyles et al. teaches a processor (see Abstract; Figs. 1-3; col. 3, line 50; col. 4, lines 44-45; col. 6, lines 40-41; col. 11, line 61) running software residing in the firmware memory if a switch (see col. 11, lines 66-67) is pressed at a time when the apparatus is turned off (see col. 5, lines 56-67; col. 6, lines 1-7). As stated above, the reference however does not explicitly teach *pressing* and *holding* the cited switch for a *predetermined period of time* as a condition to load and execute the software. Nonetheless, the reference explicitly teaches a “pressable key” or “pressure sensor” as examples of a triggering device for the purpose of controlling software (see col. 3, lines 15-23). Accordingly, one of ordinary skill in the art would have been motivated to combine the cited “power switch” and “pressure sensor” in order to discriminate among different actions to be taken regarding the step of loading the software, since Broyles et al. explicitly suggests these alternatives.

Considering claims 4 and 5, Broyles et al. discloses the use of a switch to control software residing in firmware memory (see Rejections above). However, the cited art does not teach pressing and holding the switch for a specific or variable amount of time. The reference explicitly teaches a “pressable key” or “pressure sensor” as a triggering device for the purpose of controlling software (see col. 3, lines 15-23). Accordingly, one of ordinary skill in the art would have been motivated to combine the cited “power switch” and “pressure sensor” in order to discriminate among different actions to be taken regarding loading the software, since Broyles et al. explicitly teaches this functionality. Furthermore, one of ordinary skill in the art would have been motivated to specify a period of time to hold the switch, since it is known that prior art apparatuses allow an amount of time (see col. 2, line 3) to determine if firmware software is

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loaded (see col. 2, line 5). Therefore, since the cited prior art teaches the use of a configurable switch (or “pressable key” or “pressable sensor”) to control the step of loading software, it would have been obvious to establish a period of time to cause the software to load, since the prior art teaches an amount of time for these purposes.

As for claims 6 and 7, Broyles et al. does not specify the port for the input device (see col. 3, line 50; col. 11, lines 63) as a universal serial bus port. However, the input device is specified by the reference as being a keyboard (see col. 13, lines 1-2). It is well known in the art that keyboards are connected using a universal serial bus port (USB). Therefore, it would have been obvious to specify the port for the input device as a USB port, since the input device included in the reference is a keyboard.

As for claim 8, the port disclosed by Broyles et al. is a keyboard port (see col. 13, lines 1-2).

In consideration of claim 9, the input device disclosed by the reference is a keyboard (see col. 13, lines 1-2).

Considering claim 10, the apparatus cited by Broyles et al. is a computer system (see Abstract; Figs. 1-2).

In consideration of claim 11, Broyles et al. does not explicitly cite an audio/visual entertainment appliance. The cited reference teaches the apparatus as being a computer system (see Abstract;

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Figs. 1-2). Nonetheless, it would have been obvious to one of ordinary skill in the art that computer systems are widely used for audio/visual entertainment purposes.

Regarding claims 12, 14-19, these constitute the method directed to the apparatus disclosed in claims 1, 3-11. Claims 1 and 3-11 are rejected in the present Office action as being unpatentable over Broyles et al. Since the cited art teaches or suggests all the limitations corresponding to the apparatus previously disclosed, the method claims 12 and 14-19 are rejected under the same rationale.

Regarding claim 20, Broyles et al. teaches an apparatus (see Abstract) including a processor (see Abstract) and firmware memory containing setup software (see col. 11, lines 64-65). If the cited apparatus is off (see col. 5, lines 56-60) and a switch is pressed (see col. 6, lines 2-3), then setup software is loaded and run (see col. 5, lines 26-27; col. 6, lines 3-6; col. 12, lines 60-64). The reference does not explicitly teach *pressing* and *holding* the cited switch for a *predetermined period of time* as a condition to load and execute the software. Nonetheless, the reference explicitly teaches a “pressable key” or “pressure sensor” as a triggering device for the purpose of controlling software (see col. 3, lines 15-23). Accordingly, one of ordinary skill in the art would have been motivated to combine the cited “power switch” and “pressure sensor” in order to discriminate among different actions to be taken regarding loading the software.

As for claims 22 and 23, Broyles et al. discusses the use of a switch to control software residing in firmware memory. The cited art, however, does not teach pressing and holding the switch for

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a specific or variable amount of time, as claimed. The reference explicitly teaches a “pressable key” or “pressure sensor” as a triggering device for the purpose of controlling software (see col. 3, lines 15-23). One of ordinary skill in the art would have been motivated to combine the cited “power switch” and “pressure sensor” in order to discriminate among different actions to be taken regarding loading the software, since Broyles et al. explicitly teaches this functionality. Furthermore, one of ordinary skill in the art would have been motivated to specify a period of time to hold the switch, since it is known that prior art apparatuses allow an amount of time (see col. 2, line 3) to determine if firmware software is loaded (see col. 2, line 5). Therefore, since the cited prior art teaches the use of a configurable switch (or “pressable key” or “pressable sensor”) to control the step of loading software, it would have been obvious to establish a period of time to cause the software to load.

As for claim 24, the apparatus cited by Broyles et al. is a computer system (see Abstract; Figs. 1-2).

Considering claim 25, Broyles et al. does not explicitly cite an audio/visual entertainment appliance. The cited reference teaches the apparatus as being a computer system (see Abstract; Figs. 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made that computer systems are widely used for audio/visual entertainment purposes.

Regarding claims 26, 28 and 30, these constitute the “computer readable media” directed to the apparatus disclosed in claims 1 and 3-11. Claims 1 and 3-11 are rejected in the present Office

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action as being unpatentable over Broyles et al. Since the cited art teaches or suggests all the limitations corresponding to the apparatus previously disclosed, the present claims are rejected under the same rationale.

Response to Arguments

9. Applicant's arguments filed 17 November 2003 have been fully considered but they are not persuasive. In the remarks, applicant argued in substance that "Broyles et al. does not disclose conditioning the loading of software to support an input device contained in firmware on the pressing and holding of a switch for a predetermined period of time". Examiner agrees with applicant's argument that Broyles et al does not *explicitly teach* a condition for loading the software. Nonetheless, the cited art does teach a "pressable key" and "pressure sensor" as alternative triggering devices for the purpose of controlling software (see col. 3, lines 15-23). Examiner respectfully submits that one of ordinary skill in the art would have been motivated to combine the cited "power switch" and "pressure sensor" in order to discriminate among different actions to be taken regarding loading the software, since Broyles et al. explicitly teaches this functionality. Examiner reminds applicant that a reference is to be considered not only for what it expressly states, but for what it *would reasonably have suggested* to one of ordinary skill in the art. **In re DeLisle**, 160 USPQ 806 (CCPA 1969).

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Gouzman et al. [US 6,278,441 B1] teaches pressing a key on a computer keyboard or a switch device to activate a software subroutine (see col. 13, lines 4-10).
- French [US 4,543,066] teaches pressing a reset switch in order to load software (see col. 6, lines 45-48).

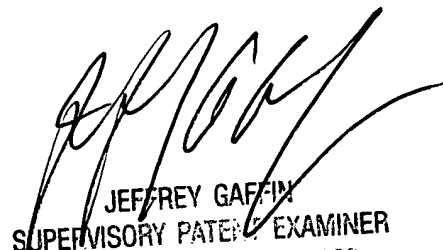
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angel L. Casiano whose telephone number is 703-305-8301. The examiner can normally be reached on 8:00-5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 703-308-3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

alc
January 31, 2004



JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100